

RemarksI. Reply to Examiner's "Response to Arguments"

The Final Rejection for the most part reiterates the prior (fifth) non-final rejection of March 20, 2007. Beginning on page 10 of the Final Rejection, however, the Examiner provides a "Response to Arguments" section that explains the Examiner's position with regard to some of Applicants' earlier arguments. Applicants in this Request for Reconsideration will only address this "Response to Arguments" section, rather than repeat the arguments previously presented.

A. The Preamble Limitations

The Examiner states, on pages 11 and 12:

In response to applicant's arguments, the recitation "storage unit including a disk drive has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

Applicants do not disagree with these early cases. Indeed, it is clear from the explanation of the cases given by the Examiner that the preamble should be considered a limitation of the present case, because it provides antecedent basis for the other limitations found in the "body of the claim," which therefore depend on the preamble.

Moreover, a more thorough explanation of whether a preamble should be viewed as a limitation, found in *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-809 (Fed. Cir. 2002), buttresses the finding that the preamble at issue in present claims should be given patentable weight. For example, as noted in *Catalina* at 808, "dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995)." As can easily be

seen, each of the independent claims has a preamble that provides antecedent support for the "claim body."

Moreover, as stated in *Catalina* at 808-809, "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. See generally *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001)." Applicants have amended independent claim 1 to add limitations to the preamble of that claim, added similar limitations to the preambles of new independent claims 21 and 28, and have argued that the preamble is a limitation in each of the independent claims, clearly relying upon those preambles to define the invention. This reliance on the preamble is a demonstration of "what the inventors actually invented and intended to encompass by the claim." *Catalina* at 808.

For these reasons, it is clear that the preamble should be considered a limitation of the independent claims. The Examiner does not dispute applicants' arguments that Bilic does not disclose the limitations of the preamble. Instead, the Examiner states that "the recitation 'storage unit including a disk drive' has not been given patentable weight because the recitation occurs in the preamble." Given the reasons explained above it should be easy for the Examiner or an Appeals Board to understand that the preambles provide limitations to the claims not found in the cited art.

B. Failure of the References to Disclose Claimed Features

The Examiner states, on page 12:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "packets transferred using different protocols go to different memories") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 11 81, 26 USPQ2d 1057 (Fed. Cir. 1993).

Bilic teaches an embedded processor detecting protocol and header information of received packets. Based on this information, it is determined whether the host processor is to process the packet or store the packet without processing by the host processor (paragraphs [0013, 0026, 0043, 0046-0048]).

Applicants note that the phrase the Examiner mentions as not being recited in the claims, that "Bilic does not even suggest that packets transferred using different protocols go to different memories, but rather states that all the packets go to the host memory," was never asserted by applicants to be found in any of the claims. Instead, it was a continuation of the argument that the cited art fails to disclose the limitation of the preamble in combination with the rest of the claim. For example, claim 1 recites in part the limitation of "the storage unit including a disk drive," in combination with the limitation of "send the data from the packet to the storage unit," which is clearly different from the cited art. The phrase the Examiner has objected to was merely offered to show something that was lacking in the cited prior art that was less different than the limitations found in the independent claims, in order to show the significance of the difference between the independent claims and the cited art.

C. Allegation that Applicants' Argument do not Comply with 37 CFR 1.111

The Examiner states, on page 12:

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicants respectfully assert that their prior reply was fully responsive. Throughout the course of this application, applicants respectfully assert that the Examiner has repeatedly, in multiple prior Office Actions as well as in the Final Rejection, alleged that features were found in reference documents that were not, in actuality, disclosed in those documents. Applicants have merely pointed out the deficiencies in those rejections, because the Office Actions and the Final Rejection have failed to present a *prima facie* rejection for anticipation or obviousness.

II. Conclusion

Applicants have shown that the Office Action has not presented a *prima facie* case of anticipation or obviousness for any of the claims. As such, applicants respectfully assert that the application is in condition for allowance, and a notice of allowance is solicited.

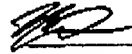
Respectfully submitted,

**CERTIFICATE OF FACSIMILE TRANSMISSION**

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